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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/749,476 | 12/31/2003 | Michael Alan Hermans | KCX-755 (18853) | 3935 |
| 22827 | 7590 | 12/12/2007 | | |
| DORITY & MANNING, P.A. POST OFFICE BOX 1449 GREENVILLE, SC 29602-1449 | | | EXAMINER FORTUNA, JOSE A | |
| | | | ART UNIT 1791 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/749,476 | Applicant(s) HERMANS ET AL. | |
| | Examiner José A. Fortuna | Art Unit 1791 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21, 22, 24-51, 53-61, 63-65 and 70 is/are pending in the application.
- 4a) Of the above claim(s) 70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21, 22, 24-51, 53-61 and 63-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 70 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly added claim, claim 70, is drawn to a process of making a tissue, while the original claims were drawn to a tissue. The inventions are patentably different, because the process of making, as claimed, can be used to make a materially different product, such as one in which the bonding material in the first surface is not in a form of drops, as required in the product claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 70 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19, 21-22, 24-51, 53-61 and 63-65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10 and 43 and 61-65 of U.S. Patent No. 7,303,650. Although the conflicting claims are not identical, they are not patentably distinct from each other because the properties of the tissues are inherently the same. Note that claims 10 and 43 teach the bonding material can be added in form of discreet droplets and claims 61-65 teach the same range of the dry and wet surface depth.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-19, 21-22, 24-51, 53-61 and 63-65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(b) as obvious over Larson et al., US

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Patent No. 6,129,815 or Anderson et al., US Patent No. 5,674,590 or Anderson et al., US Patent No. 6,248,212 or Anderson et al., US Patent No. 5,885,418.

Larson et al. would be discussed; however, the same subject matter is discussed in the other(s) references. Larson et al. teach a multi-layered paper in which a bonding agent is applied to the surfaces of the web at predetermined pattern and then one side of the web is creped, see abstract and column 4, lines 62-65. Larson et al. teach also that the creping could be done without heating the surface of the creping roll, see column 13, line 66 through column 14, line 11. Larson et al. teach that different types of fibers could be used in any of the layers of the stratified web, see column 6, lines 48-58 and teach the formation of a through-air dried web which is the bonded and creped, see column 8, lines 6-26. Larson et al. teach the use of a debonding agent in the same addition range as claimed, column 7, lines 57-65 and column 9, lines 46-65. They also teach the same form of application and coverage amount of the bonding material on the paper, see column 7, lines 7-31 and column 15, lines 10-21. The basis weight same as the one claimed are taught in column 19, lines 12-23. Even though none of the references teach the dry and wetted surface depth as claimed, these properties **Must** be inherent to the cited reference(s) since they are made by the same process with the same raw materials. Larson et al. teach bonding agent having glass transition temperatures ranging from -30°C to $+10^{\circ}\text{C}$, see column 13, lines 10-28. Larson et al. teach the heating of the web after the application of the first bonding material, see figures and column 11, lines 1-17. Note also that the normalized basis weight falls within the claimed range.

Note that the application of the bonding material in form of discrete droplets is taught by the references, see figure, especially figure 2 and figure 4 for US Patent Nos. (5,885,418 and

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5,674,590) and 6,248,212 respectively. Which further evidences that the claimed properties naturally follow from the cited references, since they are basically the same product, i.e. formed the same way, with the same raw materials, and boded in the same way as claimed, with the same bonding materials.

7. Claims 1-19, 21-22, 24-51, 53-61 and 63-65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Anderson et al., WO 99/34060.

Regarding claims 1, 5-6 and 20-21, Anderson et al. teach a multi-layered paper in which a bonding agent is applied to the surfaces of the web at predetermined pattern and then creped, see abstract and page 13, lines 1-4. Anderson et al. teach also that different types of fibers could be used in any of the layers of the stratified web, see page 6, lines 9-20. They teach the use of a debonding agent in examples 1-26, same as claimed; the same form of application and coverage amount of the bonding material on the paper, see pages 7-9, more specifically, page 8, lines 9-14; the absorbent papers having overlapping basis weight as the one claimed, see page 8, lines 15-30, page 2, lines 29-35 and page 3, lines 30-35. Even though the WO patent does not explicitly teach the dry and wetted surface depth as claimed, these properties **Must** be inherent to the cited reference(s) since they are made by the same process with the same raw materials.

Note that the application of the bonding material in form of discrete droplets is taught by the references, see figure, especially figure 2. Which further evidences that the claimed properties naturally follow from the cited references, since they are basically the same product, i.e. formed the same way, with the same raw materials, and boded in the same way as claimed, with the same bonding materials.

Response to Arguments

8. Applicant's arguments with respect to claims 1-19, 21-22, 24-51, 53-61 and 63-65 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Process of bonding and creping webs."

Tirimacco, US Patent No. 6,846,383, teaches an absorbent web which seems have, at least inherently, the same properties as the ones claimed, since they teach that the wiping product is made using the same raw materials and similar process as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF